

ESTTA Tracking number: **ESTTA397558**

Filing date: **03/11/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77902307
Applicant	JOFEMAR, S.A.
Correspondence Address	JOHN A. CLIFFORD MERCHANT & GOULD P.C. PO BOX 2910 MINNEAPOLIS, MN 55402-0910 UNITED STATES jclifford@merchantgould.com
Submission	Applicant's Motion to Suspend
Attachments	Request Suspension and Remand.pdf ( 4 pages )(164820 bytes )
Filer's Name	Danielle I. Mattessich
Filer's e-mail	kkunkel@merchantgould.com
Signature	/daniellemattessich/
Date	03/11/2011

Re: ESTTA391303  
Appeal re Application Serial No. 77-902307  
Mark: EASYFLEX  
Applicant: Jofemar, S.A.

### **REQUEST SUSPENSION**

It is respectfully requested that the above Appeal proceedings be suspended and the application be remanded to the Examining Attorney for reconsideration. It is believed that the Consent submitted herewith is such that the Examining Attorney's Section 2(d) refusal could be withdrawn if the case is returned to her for reconsideration. By remanding this case, the Trademark Trial and Appeal may not need to hear this appeal.

If this request for suspension and remand is not granted, it is respectfully requested that the Board reset the time so that Applicant has sufficient time to file its brief.

### **REQUEST REMAND AND RECONSIDERATION**

The Examining Attorney has issued a final refusal of registration in this case based on a likelihood of confusion under Section 2(d) of the Trademark Act in view of Registration No. 3204494 for EZ-FLEX for conveyors and belts for conveyors. Applicant has completed negotiations for a Consent to Register its mark "EASYFLEX" from the owner of the cited prior registration, Monster Metal Works, Inc. A copy of the Consent is attached.

Applicant believes that there would be no likelihood of confusion in the marketplace based on the differences in the parties' marks, goods and the channels of trade of the respective products. As evidenced by the enclosed consent from the owner of the cited registration, Registrant also does not believe there is a likelihood of confusion. Moreover, the agreement details the reasons why no likelihood of confusion exists in this case and the arrangements undertaken by the parties to avoid any potential confusion to the public in the future.

The Court of Appeals for the Federal Circuit has made it clear that consent agreements should be given great weight, and that the Office should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other factors clearly dictate a finding of likelihood of confusion. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Bongrain International (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479,

1 USPQ2d 1775 (Fed. Cir. 1987); and *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985). It is, therefore, respectfully requested that the Examining Attorney withdraw the § 2(d) refusal.

In view of the foregoing, it is submitted that the application is now in condition for publication. Should the Examining Attorney have any questions, she is encouraged to contact the Applicant's attorney, John A. Clifford, at 612-336-4616.

# Merchant & Gould

An Intellectual Property Law Firm

3200 IDS Center  
80 South Eighth Street  
Minneapolis, Minnesota  
55402-2215 USA  
TEL 612.332.5300  
FAX 612.332.9081  
www.merchant-gould.com

A Professional Corporation

Direct Contact

John A. Clifford  
612.336.4616  
jclifford@merchant-gould.com

March 1, 2011

Scott Taylor  
Monster Metal Works, Inc.  
P.O. BOX 1054  
Young Harris, GA 30582

Re: Jofemar, SA use of the trademark EASYFLEX  
Our Ref: 60395.14US01

Dear Mr. Taylor:

Our firm represents Jofemar, S.A. a leading maker of vending machines and related products. Jofemar, S.A. is using the trademark EASYFLEX for vending machine parts, namely conveyors in the vending machine industry. They have used the mark since at least the year 2005. We have learned of the existence of a trademark Registration No. 3,204,494 for the mark EZ-FLEX registered for conveyors, belts for conveyors based on first use in March of 2005.

We believe that the goods of Jofemar, S.A. travel in distinct and separate channels of trade from those occupied by Monster Metal Works, Inc. under the EZ-FLEX trademark. We have reviewed the specimen you filed with your trademark application and note the goods are industrial in nature and would be located in a factory setting. On the other hand, the product of Jofemar is an internal working component within a vending machine of the type that dispenses food, drinks, or other relatively small items through a vending machine. And Jofemar, S.A. agrees to limit the use of the EASYFLEX mark to the internal working components within vending machines. We therefore believe there is no likelihood of confusion presented by the simultaneous use by Monster Metal Works of the EZ-FLEX mark and Jofemar, S.A. using the EASYFLEX mark. We trust you will agree.

We therefore ask that you consent to the use and registration by Jofemar, S.A. of the mark EASYFLEX for vending machine parts, namely conveyors. We further ask that you consent to the registration of the mark shown in U.S. trademark application Serial No. 77/902,307 filed by Jofemar, S.A.

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March 1, 2011  
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We agree that should instances of actual confusion become known to either party, the parties will contact each other and will work in good faith to reduce or eliminate any such confusion from the marketplace.

We expect you will find the explanation contained in this letter sufficient to allow you to agree with this request. If you are agreeable, please sign below indicating your consent to this request. Please feel free to contact me should you have any questions about this matter.

After signing, please return the letter to me via FedEx in the enclosed, FedEx envelope. The shipping charges will be paid by me. Thank you for your prompt attention to this matter.

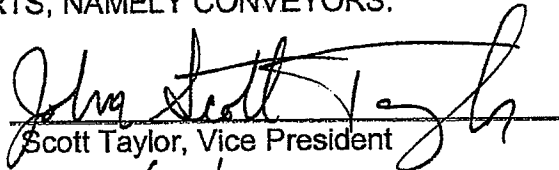
Sincerely,



John A. Clifford  
JAC/ASM/aeb

ON BEHALF OF MONSTER METAL WORKS, INC., IT IS AGREED THAT JOFEMAR, S.A. MAY USE AND REGISTER THE EASYFLEX TRADEMARK SHOWN IN APPLICATION SERIAL NO. 77/902,307 FOR VENDING MACHINE PARTS, NAMELY CONVEYORS.

BY:

  
Scott Taylor, Vice President

DATE:

3/3/11